

REMARKS

Upon entry of the present amendment, claim 4 will be canceled without prejudice or disclaimer of the subject matter recited therein; claims 1 and 7-9 will be amended; and claims 11-18 will be added, whereby claims 1-3 and 5-18 will be pending.

Support for the amendment to the claims appears in the originally filed application, including the originally filed claims. In this regard, claim 1 has been amended to include the subject matter of canceled claim 4; claims 7 and 8 have been amended to remove parentheses; and claim 9 has been amended in a similar manner to claim 1 as well as to explicitly include formula (I); and claims 11-18 are similar to original claims 5-8.

Reconsideration of the rejections of record and allowance of the application are respectfully requested.

Claim of Foreign Priority

The Cover Sheet of the Office Action acknowledges the claim of foreign priority as well as receipt of the certified copy which should, in fact, be indicated as having been received in this national stage application from the International Bureau. However, on page 2 of the Office Action, the claim of priority based upon JP 2002-198197, filed July 8, 2002 is indicated to not be valid. No explanation is provided as to why the Examiner considers the claim of priority to be invalid.

Applicants request that the claim of foreign priority be properly acknowledged along with receipt of the certified copy in this national stage application.

Information Disclosure Statement

Applicants express appreciation for the Examiner's confirmation of consideration of Applicants' Information Disclosure Statement, filed August 15, 2005, and Supplemental Information Disclosure Statement, filed June 8, 2006, by including initialed copies of the Forms PTO-1449 with the Office Action.

A Second Supplemental Information Disclosure Statement has been filed on April 3, 2008, and the Examiner is requested to confirm consideration of this Second Supplemental Information Disclosure Statement by including an initialed copy of the Form PTO-1449 submitted therewith with the next communication from the Patent and Trademark Office.

Response To Rejection Under 35 U.S.C. 112, First Paragraph

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In this ground of rejection, it is asserted that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The rejection contends that the claims lack adequate support in the specification. The rejection contends that R3 and the phraseologies "a substituent for trapping" and "a ring structure for trapping" are not defined in the specification so as to ascertain the structure of the substituent and the ring. Moreover, the rejection contains that the specification fails to disclose "how" the step of selecting a combination of R1, R2 and R3 is performed.

In response, Applicants direct the Examiner's attention to their originally filed specification, such as beginning at the bottom of page 6 through page 8 and the Examples. This disclosure provides discussion and exemplification of various terms, including "trapping" as well

as refers to various documents in the first paragraph at the top of page 8. This disclosure clearly shows that Applicants were in possession of the claimed subject matter at the time the application was filed.

Claims 1-10 are also rejected under 35 U.S.C. 112, first paragraph, because is it asserted that the specification does not reasonably provide enablement to make and use the compounds.

In response, Applicants again direct attention to Applicants' originally filed specification wherein sufficient guidance is provided regarding the compounds and the manner of making and using the compounds so as to enable the claimed subject matter. For example, attention is once again particularly directed to pages 6 to 8 of Applicants' specification and the Examples.

If this ground of rejection is maintained, the Examiner is respectfully requested to indicate, as required by the case law cited in the rejection, technical reasoning as to why the claimed subject matter is considered to require undue experimentation.

Accordingly, the rejections based upon 35 U.S.C. 112, first paragraph, as without appropriate basis, and should be withdrawn.

Response To Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for the use of terminology including "a substituent for trapping" and "a ring structure for trapping".

In response to this ground of rejection, Applicants submit that the one having ordinary skill in the art would readily understand the scope of the claimed subject matter. For example, the Examiner's attention is once again directed to, for example, page 8 of Applicants specification wherein "trapping" is discussed.

Therefore, the metes and bounds of the claims is readily ascertainable and this ground of rejection should be withdrawn.

Response To Art Based Rejections

The following art based rejections are set forth in the Office Action.

(a) Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Minta et al., J. Biol. Chem. (1980), Vol. 264(14), pp.8171-78.

(b) Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagano et al., WO 99/51586 (US equivalent 6,525,088 B1).

(c) Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagano et al., WO 01/62755 (US equivalent 6,903,226 B2)

(d) Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagano et al., EP 1 069 121 A1.

In response to these rejections, Applicants note that rejections (b), (c) and (d) are asserted to include R3 being carboxylic acid or ester. As claim 1 excludes R3 being a carboxyl group, these rejections are without appropriate basis.

Regarding rejection (a), Applicants note that Fluo-1 disclosed in Fig. 2 of Minta includes R3 being an OH group. As presently recited, the claims include that R3 is a lower alkyl group or a lower alkoxy group.

Accordingly, none of the documents cited in rejections (a)-(d) discloses each and every feature recited in Applicants' claims, and the anticipation rejections should be withdrawn.

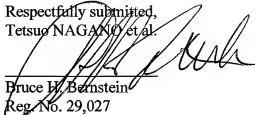
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow each of the pending claims.

Applicants therefore respectfully request that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Should the Examiner have any questions regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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